

**REMARKS**

Claims 1-32 are pending, with claims 1, 4, 8-10, 15 and 19 amended and claims 21-32 added by the present amendment.

In the Official Action, claims 1, 2, 6, 7, 15, 16, 19 and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,513,278 to Hashizume et al. (hereinafter "Hashizume"), claims 3 and 8-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashizume; and claims 4, 5, 12-14, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashizume and further in view of U.S. Patent No. 5,367,453 to Capps et al. (hereinafter "Capps").

Claims 1, 4, 15 and 19 are amended and claims 21-32 are added to recite additional features from Applicants' originally filed specification.<sup>1</sup> No new matter is added.

Briefly recapitulating, amended claim 1 is directed to

A method, comprising:

receiving electronic ink input;

converting the electronic ink input to one or more machine-generated objects; and

rendering the one or more machine-generated objects such that a size and an inter-word spacing of the rendered machine-generated object or objects substantially corresponds to an original size and an original inter-word spacing of the electronic ink input.

Independent claims 15 and 19 are directed to a system and computer program product for performing the method of claim 1.

Hashizume describes a handwritten character recognition unit that recognizes a character inputted with a pen of a pen input device according to coordinate data of the character. The

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<sup>1</sup> Specification, paragraph 44 and Fig. 7b.

device of Hashizume includes a font ROM 40 that stores font data which is specified by the character code and the character size. Upon receiving a pen input, character area judge unit 3a selects a character size which corresponds to inscribed area data by applying area data to a character size judge table. As shown in the example, characters "B", "M", and "s" may be shown in double size, vertically double size, and standard depending on the inscribed area data.

In Hashizume, a blank area judge unit 3b sets blank areas between characters. For example, divided areas 2 and 3 are set as blank areas when the character "M" is inputted at vertically double size, and the divided area 3 is set as blank area when the character "s" is inputted at standard size. The blank area information is provided to a character code generation unit 4. Then, the handwritten character area judge unit 3 provides the character size information to the character font determination unit 5.

Character code generation unit 4 generates a character code in accordance with the recognized character and the blank area. When generating the character code, the character code generation unit 4 refers to a character code table or the like which stores relations between the stroke data and the respective character code.

The character font determination unit 5 receives the character code data and the character size data from the character code generation unit 4 and the handwritten area judge unit 3, respectively. The character font determination unit 5 detects font data from the font data storage (font ROM) 40 which corresponds to the character code and the character size data, and extracts the font data. The display device 30 receives the extracted font data, and displays the data within the sub-window 32. FIG. 11 of Hashizume shows this displaying state.

As an option, a user of the device of Hashizume can select either whether or not to change a character font in accordance with the size of the pen input handwriting. Also, the number of divided areas in Hashizume may vary from a standard size to multiple sizes.

However, Hashizume does not disclose or suggest rendering the one or more machine-generated objects such that a size *and an inter-word spacing* of the rendered machine-generated object or objects substantially corresponds to an original size and *an original inter-word spacing* of the electronic ink input. In Hashizume, input regions are predefined for the input of individual characters. The input regions are divided into quadrants so as to accommodate “standard size”, “double size”, and “vertically doubled size” characters. If a character is written into the lower left quadrant, a “standard size” font is determined. If the character is written across all four quadrants, a “double size” font is determined. If the character is written across the upper left and lower left quadrant, a “vertical double size” font is determined.

However, the device shown in the figures of Hashizume only allows the input of up to 4 individual characters, and does not accommodate the input of multiple words. Assuming, *arguendo*, that a tablet included multiple rows of Hashizume quadrants, and that spaces between words could be accounted for by skipping quadrants, the device of Hashizume would not render the input such that a size *and an inter-word spacing* of the rendered machine-generated object or objects substantially corresponds to an original size and *an original inter-word spacing* of the electronic ink input. That is, there is no provision for the components of Hashizume to determine whether a space between words in Hashizume is more or less extended from a preset value.

MPEP § 2131 notes that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.02. “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because Hashizume does not disclose or suggest all of the features recited in claims 1, 15 and 19, Hashizume does not anticipate the invention recited in claims 1, 15 and 19, and all claims depending therefrom.

Similarly, Hashizume does not disclose or suggest electronic ink input being a table, and said inter-word spacing as a corresponding table column-spacing; or normalizing said inter-word spacing in response to a user-generated normalization command, as recited in claims 24-26 and 27-29, respectively.

Turning now to the current rejections under 35 U.S.C. § 103(a), Applicants submit that amended claims 8-11 are not obvious in view of the applied references. As noted above, Hashizume only renders individual characters. Hashizume does not disclose or suggest determining the original size of the electronic ink text input on a word-by-word basis, wherein two words are separated by said original inter-word spacing. Similarly, Hashizume does not disclose or suggest determining the original size of the electronic ink text input as an average size of a line of the electronic ink text input, on a line-by-line basis, wherein at least one line includes at least two words separated by said original inter-word spacing.

Regarding claim 4, as acknowledged in the Official Action, Hashizume does not disclose or suggest receiving input selecting at least one object from the rendered machine-generated

object or objects, and displaying the electronic ink input corresponding to the selected machine-generated object or objects. To cure this deficiency, the Official Action applies Capps. Fig. 6a of Capps describes an intelligent spell checker that displays options in a table along with an original electronic pen input. However, Capps does not disclose or suggest displaying the electronic ink input corresponding to the selected machine-generated object or objects in place of the selected at least one object.

As none of the cited art, individually or in combination, discloses or suggests at least the above-noted features of dependent claims 4 and 8-11, Applicants submit the inventions defined by claims 4 and 8-11, and all claims depending therefrom, are not rendered obvious by the asserted references for at least the reasons stated above.<sup>2</sup>

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<sup>2</sup> MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest **all** the claim limitations.

Conclusion

All matters having been addressed in view of the foregoing, Applicants respectfully request the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

Applicants' undersigned representative remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter. If any point remains an issue in which the Examiner feels would be best resolved through a personal or telephone interview, please contact Michael Monaco, Registration No. 52,041, or the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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